

## **REMARKS**

### **I. Status of the Subject Application**

At the outset, Applicant wishes to express appreciation to Examiner Horton for determining that the subject application contains patentable subject matter.

Claims 1, 4-24, 27-37, 42, 43 and 45-49 are pending in the subject application. Claims 21-24, 27-37, 42, 43, and 45-49 are allowed. Claims 4, 5, 12-15 and 17-20 are objected to. Claims 1, 6-11 and 16 stand rejected.

### **II. The Rejections Under 35 U.S.C. § 102(b)**

Claims 1, 6 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,693,047 to Menchetti. The Official Action provides that “Menchetti discloses the use of a stud bridging/spacing system including a plurality of spaced apart studs (14) having a web (18); wherein the system comprises a bridging member (20) for spanning the webs (16) of studs (14) and a bracket (26) attachable to the bridging member (20) and at least a notch (34) at an incline to the bridging (20).”

Responsive to this rejection Applicant respectfully submits that Menchetti fails to disclose each and every element of claim 1 in the same form as recited in that claim and, therefore, cannot anticipate the subject matter of that claim. In particular, tab (26) of Menchetti is not a bracket that is attachable to the bridging member; **tab (26) is part of the stud**. In particular, Menchetti provides:

The bendable tabs 26, in the preferred embodiment, are made in the form of a small section of the stud web sheet metal...

Column 2, lines 40-47 of Menchetti. Thus, for this reason alone, Menchetti cannot anticipate claim 1. In addition, claim 1 recites that at least one **notch** “is configured to receive a portion of a **stud** therein.” Claim 1 (emphasis added). As can be seen in Figure 2 of Menchetti, the teeth (34) engage the channel (20) **and not the stud** as recited in claim 1. Notably, Menchetti provides:

Bottom edge 28 is preferably lightly serrated with teeth 34 to more firmly grasp the **channel** side 30.

Column 2, lines 56-58 of Menchetti (emphasis added). Thus, the tabs (26) that are integrally formed in the web of the stud (which increase the manufacturing costs of each stud) do not satisfy the recitations of claim 1 and therefore Menchetti cannot anticipate that claim.

Accordingly, Applicant traverses this rejection.

With respect to claim 16, the Official Action provides that “the bracket (44) is attached to the bridging member (20) by removable fasteners (9) disposed within the wall.” This rejection suggests that the spring clip (44) is equivalent to the bracket recited in claim 1. Applicant respectfully disagrees for the following reasons. Claim 1 recites in pertinent part:

at least one notch formed in said bracket such that when said bracket is attached to said bridging member, at least one said notch extends at an incline to the elongated axis of said bridging member and is configured to receive a portion of a stud therein.

Applicant submits that the spring clip (44) of Menchetti lacks the recited notch. Moreover, the spring clip is not “attached to the bridging member”. Finally, **no portion** of the spring clip

receives any portion of the stud therein. Accordingly, Menchetti cannot anticipate the subject matter of claim 16.

### III. The Rejections Under 35 U.S.C. § 103

Claims 6-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Menchetti. The Official Action provides:

In reference to claims 6 and 11, Menchetti discloses the basic claimed structure except for explicitly detailing the gauge of the metal material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the known material suitable for the use intended as an obvious matter of design choice. For instance a heavier gauge material is suitable for structure requiring more sturdiness; whereas other structures may require much lighter metals.

Applicant respectfully submits that, as was discussed above, Menchetti does not disclose the basic claimed structure and the record fails to point to any motivation that would have led a person of ordinary skill in the art to make the significant modifications to the channel and studs of Menchetti to satisfy the recitations of claim 1. Furthermore, such modifications would impermissibly alter the manner in which the Menchetti retainer system operates.<sup>1</sup> Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to claims 6 and 11.

With respect to claims 7 and 8, the Official Action provides that:

[I]t would have been obvious to one having ordinary skill in the art at the time the

---

<sup>1</sup> See, *Manual of Patent Examining Procedure* § 2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”) (citation omitted).

invention was made to select the width of the notches suitable for the use intend [sic] and the size of the bridging member as an obvious matter of design choice. Certainly larger notches are needed to accommodate larger size bridging member and vice-versa.

Responsive to this rejection Applicant respectfully submits that claim 1 does not require the notches to engage the bridging member as suggested in the Official Action. Claim 1 recites that at least one notch is configured to receive a portion of a **stud** therein. Again, Applicant submits that there is no motivation to make the significant modifications to the retainer of Menchetti to satisfy the recitations of claim 1 or claims 7 and 8 which depend from claim 1. Thus, a *prima facie* case of obviousness has not been established with respect to claims 7 and 8.

With respect to claims 9 and 10, the Official Action provides that the “applicant has shown no criticality for the notches being straight, parallel or angled. Hence the selection of either would be within the general skill of a work in the art.” As was stated above, there has been no showing of motivation that would have led the skilled artisan to modify the retainer of Menchetti to achieve the member of claim 1. Thus, for these reasons alone, a *prima facie* case of obviousness has not been established with respect to claims 9 and 10, which depend from claim 1. Furthermore, Section 2143.01 of the Manual of Patent Examining Procedure (“MPEP”) provides:

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS.

Accordingly, regardless of whether it would have been within the capabilities of the person of ordinary skill in the art to make the sides of the notches straight and/or parallel, is not sufficient

alone to render claims 9 and 10 unpatentable. Thus, for this reason and the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claims 9 and 10.

#### **IV. Supplemental Information Disclosure Statements**

##### **A. Supplemental Information Disclosure Statement of September 18, 2003**

On September 18, 2003, Applicant submitted a Supplemental Information Disclosure Statement along with Applicant's Amendment. A check (Check No. 1002249) for \$180 was also enclosed in connection with that Supplemental Information Disclosure Statement. Applicant has not received an initialed copy of PTO Form SB/08A confirming that the art cited thereon has been considered. Copies of the following documents are enclosed:

- The September 18, 2003 Supplemental Information Disclosure Statement
- The PTO Form SB/08A
- The Express Mail Certificate
- A copy of the self-addressed stamped post card that accompanied the Amendment and IDS bearing the PTO's September 18, 2003 date stamp.

Consideration of the September 18, 2003 Supplemental Information Disclosure Statement is requested.

##### **B. Additional Supplemental Information Disclosure Statement**

Applicant has also enclosed an additional Supplemental Information Disclosure Statement. Consideration of the additional Supplemental Information Disclosure Statement is respectfully requested.

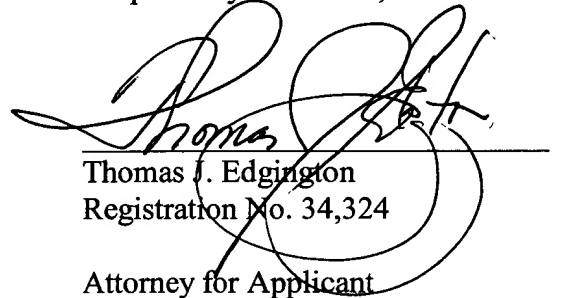
*Application Serial No. 09/888,897*  
*Amendment dated October 6, 2004*  
*Reply to Official Action of July 6, 2004*

**V. Conclusion**

Applicant submits that all of the pending claims are in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections in the Official Action and passage to allowance of all the pending claims at an early date are earnestly solicited. However, if the Examiner has any remaining concerns regarding Applicant's present Amendment, she is invited to contact the Applicant's undersigned attorney at the telephone number listed below so that those concerns may be expeditiously addressed.

Respectfully submitted,



Thomas J. Edgington  
Registration No. 34,324  
Attorney for Applicant

Kirkpatrick & Lockhart LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222  
(412) 355-8303